



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,693	01/19/2001	Daniel S. Sem	P-TB 4568	6461

23601 7590 10/20/2003
CAMPBELL & FLORES LLP
4370 LA JOLLA VILLAGE DRIVE
7TH FLOOR
SAN DIEGO, CA 92122

EXAMINER

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
----------	--------------

1639

DATE MAILED: 10/20/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory ActionApplication No.
09/765,693

Applicant(s)

Sem

Examiner

Maurie G. Baker, Ph.D.

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Sep 18, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires THREE months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Please see attached.

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____


Claim(s) rejected: 42-56

Claim(s) withdrawn from consideration: 15-19, 37-41, and 57-61

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____


MAURIE G. BAKER, PH.D.
PRIMARY EXAMINER
ART UNIT 1639

ADVISORY ACTION*Attachment*

1. Applicant's After Final amendment filed September 18, 2003 raises new issues which would require further search and/or consideration and does not place the case in better form for appeal or in condition for allowance. Moreover, the proposed amendment contains new matter (see paragraph 3 below). Thus the amendment will not be entered.
2. Applicant proposes to substantively amend claims 42 and 47. The proposed amendatory matter changes the scope of the claims and would require further search and/or consideration. For example, the previously examined versions of claims 42 and 47 had no mention of a "module"; no linker having "sufficient length and orientation to direct a second ligand to a substrate binding site"; and no steps of "generating a population" or "screening said population". Previously examined claim 52 is not proposed to be amended and the rejections of the claim would be maintained for reasons of record and the further reasons set forth below.
3. Also, the proposed amendments to claims 42 and 47 would necessitate, at the least, new rejections under 35 U.S.C. 112, first paragraph. Specifically, the proposed claims contain *new matter*. The specification as originally filed does not provide support for the proposed claims. Applicant's amendment points to certain portions of the instant specification for support (After Final amendment, page 14); however, the cited portions do not provide specific support for the proposed amendatory matter.
4. Applicant's arguments are moot in view of the non-entry of the amendment. Due to the non-entry of the amendment, all previous rejections are maintained for reasons of record. However, in the interest of compact prosecution, the following is noted.

5. Applicant argues the restriction of the claims in the After Final amendment pages 14-15. This issue was discussed by the examiner in the previous action and the Restriction was made FINAL. Note that restriction is a petitionable issue, not an appealable one. However, applicant's comments will be addressed if prosecution is continued in the instant case.

6. Applicant argues the rejections of record. The examiner responded to arguments concerning the rejections of record at length in the last office action and this position is maintained. Applicant also sets forth a new argument with respect to the Radzicka reference. This is not found persuasive. Moreover, there is not a showing of good and sufficient reasons why such an argument was not earlier presented.

7. Applicant also makes mention of the prosecution in related case 09/765,696. Each case is examined on its own merits and thus the prosecution in one case is irrelevant to another case. Moreover, importantly, case 09/765,696 is drawn to a different invention than that which is instantly claimed. Case 09/765,696 concerns bi-ligands, NOT bi-target ligands.

8. Lastly, applicant argues that since the claims are drawn to methods of identifying bi-target ligands (and not bi-target ligands per se) the claims are adequately described. However, adequate description of *what is identified* in the claimed method is required and is deemed to be lacking in the instant case. The functional activity described in the claims is not sufficient.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any

inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
October 15, 2003

A handwritten signature in black ink, appearing to be 'MB' followed by a long horizontal stroke.

MAURIE GARCIA BAKER PH.D.
PRIMARY EXAMINER